

REMARKS

Claims 1-60 are all the claims pending in the application.

Claims 3, 7, 8, 12, 17-19, 28-31, 38 and 44-60 have been withdrawn from consideration.

Claim 33 has been amended for additional clarity.

Claims 1, 2, 4-6, 9-11, 13-16, 20-27, 32-37 and 39-43 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Seino et al. (U.S. Patent No. 6,361,138; hereinafter "Seino").

Applicant submits the following in traversal of the claim rejections.

Applicant maintains that claim 1 is patentable because Seino fails to disclose or suggest an ink cartridge wherein the recess includes a first width along a carriage moving direction, the protrusion includes a second width along the carriage moving direction, the first width and the second width being substantially the same, in combination with other elements of the claim.

On page 12 of the Office Action, the Examiner argues that:

The applicant has also added a limitation concerning the width of the recess (positioned along a carriage moving direction) as compared to the width of the protrusion (also positioned along a carriage moving direction). As shown in the rejection above, this is naturally suggested in view of figure 3B and 4B. As the examiner discussed in the interview, the invention of Seino et al. is presumed to work. If the protrusion (guiding protruding portion) did not fit into the recess (positioned recessed portion) drawn in to figure 3B, the invention of Seino et al. would not work.

Essentially, the Examiner's arguments are based on what is "naturally suggested," and on the device of Seino being "presumed to work." Applicant respectfully disagrees.

First, as implicitly conceded by the Examiner, Applicant submits that Seino does not explicitly disclose, inter alia, a recess including a first width along a carriage moving direction and a protrusion including a second width along the carriage moving direction, the first width and the second width being substantially the same. Hence, the Examiner relies on alleged inherent teachings of Seino as disclosing or suggesting the claimed recess and protrusion.

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP 2112(IV) quoting Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Further, it is well established that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” Id. quoting In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); see In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In the present application, the Examiner does not provide a basis in fact and/or technical reasoning to reasonably support the determination that a recess including a first width along a carriage moving direction and a protrusion including a second width along the carriage moving direction, the first width and the second width being substantially the same, necessarily flows from the teachings of Seino and the prior art.

In the Office Action, the Examiner alleges that the claimed recess and the protrusion portions are “naturally suggested” As the basis in fact and/or technical reasoning, the Examiner

states that “[i]f the protrusion (guiding protruding portion) did not fit into the recess (positioning recessed portion) drawn in to figure 3B, the invention of Seino et al would not work.” Applicant respectfully disagrees in that it would not be essential to make a width of the portion, which the Examiner refers to as “guiding protruding portion,” to be substantially identical to a width of the portion of Seino, which the Examiner refers to as the “positioning recessed portion.”

For example, the entire width of the cartridge 2 fitted inside the carriage 11 may provide the necessary alignment of the electrodes to make Seino “work.” Alternatively, the interface between the ink supply port of the cartridge 2 and the carriage 11 may provide the necessary alignment of the electrodes to make Seino “work.” Because there are other alternative reasonable bases, the Examiner cannot argue that the “guiding protruding portion” and the “positioning recessed portion” of Seino as providing the alignment of the electrodes necessarily flows from the prior art. Therefore, Seino does not inherently disclose, or even teach or suggest, the claimed recess including a first width along a carriage moving direction and a protrusion including a second width along the carriage moving direction, the first width and the second width being substantially the same.

Since the Applicant may not be aware of all of the nuances of all case law relating to patents, Applicant requests the Examiner to provide the legal basis for the proposition that natural suggestions provide a basis for rejecting claims under 35 U.S.C. § 102.

Given the lack of any apparent legal basis, Applicant submits that the rejection of claim 1 is based on improper hindsight.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. APPLN .NO.: 10/025,821

ATTY DOCKET NO.: Q67781

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

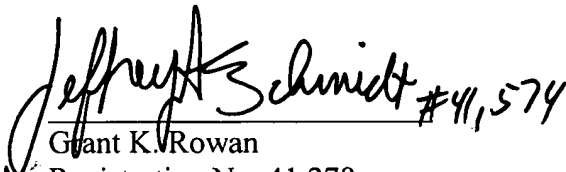
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Date: October 25, 2006